

1 STEPHEN P. SWINTON (106398)
J. CHRISTOPHER JACZKO (149317)
2 COOLEY GODWARD LLP
4401 Eastgate Mall
3 San Diego, CA 92121
Telephone: (858) 550-6000
4 Facsimile: (858) 550-6420

5 R. WILLIAM BOWEN, JR. (102178)
GEN-PROBE INCORPORATED
6 10210 Genetic Center Drive
San Diego, CA 92121-4362
7 Telephone: (858) 410-8918
Facsimile: (858) 410-8637

8 Attorneys for Plaintiff
9 GEN-PROBE INCORPORATED

10 UNITED STATES DISTRICT COURT
11 SOUTHERN DISTRICT OF CALIFORNIA
12

13 GEN-PROBE INCORPORATED,

14 Plaintiff,

15 v.

16 VYSIS, INC.,

17 Defendant.
18
19
20

No. 99CV2668 H (AJB)

**NOTICE OF MOTION AND MOTION OF GEN-
PROBE INCORPORATED FOR PARTIAL
SUMMARY JUDGMENT OF NON-INFRINGEMENT
UNDER THE DOCTRINE OF EQUIVALENTS**

Date: November 13, 2001

Time: 10:30 a.m.

Dept.: Courtroom 1

21 **TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD HEREIN:**

22 PLEASE TAKE NOTICE that on November 13, 2001 at 10:30 a.m. in Courtroom 1 of the
23 above entitled court located at the United States Courthouse, 940 Front Street, San Diego,
24 California 92101, plaintiff Gen-Probe Incorporated ("Gen-Probe") will and hereby does move the
25 Court under Federal Rule of Civil Procedure, Rule 56 for partial summary judgment under Counts
26 One and Three of its Second Amended Complaint that its nucleic acid test for human
27 immunodeficiency virus ("HIV") and hepatitis C virus ("HCV") does not infringe the claims of
28 U.S. Patent No. 5,750,338 (the "338 patent") under the doctrine of equivalents. The grounds of

1 this motion are that there is no disputed issue of material fact that Gen-Probe's HIV and HCV test
2 kit does not contain each of the claim limitations of the '338 patent and thus does not infringe that
3 patent. In particular, the methods and kits claimed in the '338 patent are limited to using only non-
4 specific amplification methods. Gen-Probe's HIV and HCV test kit, on the other hand, uses a
5 method of specific amplification which performs a substantially different function in a
6 substantially different way to achieve a substantially different result from non-specific methods of
7 amplification.

8 This Motion is based on this Notice of Motion and Motion, the accompanying
9 Memorandum of Points and Authorities, the Declaration of Dr. Matthew Longiaru, the Declaration
10 of Kary B. Mullis, Ph.D., the Declaration of Michael Harpold, Ph.D., the Notice of Lodgment, and
11 on such other and further oral and documentary evidence as the Court may consider at the time of
12 the hearing.

13 Dated: October 16, 2001

STEPHEN P. SWINTON
J. CHRISTOPHER JACZKO
COOLEY GODWARD LLP

R. WILLIAM BOWEN, JR.
GEN-PROBE INCORPORATED

By: 
Stephen P. Swinton

Attorneys for Plaintiff
GEN-PROBE INCORPORATED

PROOF OF SERVICE
(FRCP 5)

I am a citizen of the United States and a resident of the State of California. I am employed in San Diego, State of California, in the office of a member of the bar of this Court, at whose direction the service was made. I am over the age of eighteen years, and not a party to the within action. My business address is 4401 Eastgate Mall, San Diego, California 92121. On the date set forth below I served the documents described below in the manner described below:

1. NOTICE OF MOTION AND MOTION OF GEN-PROBE INCORPORATED FOR PARTIAL SUMMARY JUDGMENT OF NON-INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS
2. MEMORANDUM OF POINTS AND AUTHORITIES OF PLAINTIFF GEN-PROBE INCORPORATED IN SUPPORT OF ITS MOTION FOR PARTIAL SUMMARY JUDGMENT OF NON-INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS
3. DECLARATION OF DR. KARY B. MULLIS IN SUPPORT OF GEN-PROBE INCORPORATED'S MOTION FOR PARTIAL SUMMARY JUDGMENT OF NON-INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS
4. SEPARATE STATEMENT OF UNDISPUTED FACTS IN SUPPORT OF PLAINTIFF GEN-PROBE INCORPORATED'S MOTION FOR PARTIAL SUMMARY JUDGMENT OF NON-INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS
5. NOTICE OF LODGMENT IN SUPPORT OF PLAINTIFF GEN-PROBE INCORPORATED'S MOTION FOR PARTIAL SUMMARY JUDGMENT OF NON-INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS

(BY U.S. MAIL) I am personally and readily familiar with the business practice of Cooley Godward LLP for collection and processing of correspondence for mailing with the United States Postal Service, and I caused such envelope(s) with postage thereon fully prepaid to be placed in the United States Postal Service at San Diego, California.

(BY MESSENGER SERVICE) by consigning the document(s) to an authorized courier and/or process server for hand delivery on this date. See attached Proof of

1 Personal Service.

2 (BY FACSIMILE) I am personally and readily familiar with the business practice
3 of Cooley Godward llp for collection and processing of document(s) to be
4 transmitted by facsimile and I caused such document(s) on this date to be
5 transmitted by facsimile to the offices of addressee(s) at the numbers listed below.

6 (BY OVERNIGHT MAIL) I am personally and readily familiar with the business
7 practice of Cooley Godward llp for collection and processing of correspondence for
8 overnight delivery, and I caused such document(s) described herein to be deposited
9 for delivery to a facility regularly maintained by Federal Express for overnight
10 delivery.

11 on the following part(ies) in this action:

12 Thomas W. Banks, Esq.
13 Finnegan, Henderson, Farabow, Garrett &
14 Dunner, LLP
15 245 First Street, 18th Floor
16 Cambridge, MA 02142
17 Tel: (617) 444-8508
18 Fax: (617) 444-8608
19 Attorneys for Vysis, Inc.

John H. L'Estrange, Jr. Esq.
Wright and L'Estrange
701 B Street, Suite 1550
San Diego, CA 92101
Tel: (619) 231-4844
Fax: (619) 231-6710
Attorneys for Vysis, Inc.

16 **VIA FACSIMILE & OVERNIGHT**
17 **SERVICE**

18 Charles Lipsey, Esq.
19 L. Scott Burwell, Esq.
20 Finnegan, Henderson, Farabow, Garrett &
21 Dunner, LLP
22 1300 I Street, N.W.
23 Washington, DC 20005-3315
24 Tel: (202) 408-4000
25 Fax: (202) 408-4400
26 Attorneys for Vysis, Inc.

~~VIA FACSIMILE & PERSONAL SERVICE~~

pm *only*

23 **VIA FACSIMILE & OVERNIGHT**
24 **SERVICE**

25 Executed on October 16, 2001, at San Diego, California.

26 
Sylvia M. Tether

1 **PROOF OF PERSONAL SERVICE**

2
3 I hereby declare:

4 I am employed in the City of Diego, County of San Diego, California; I am over the age of
5 eighteen years and not a party to the within cause; my business address is Knox Services, 2201
6 East Fourth Street, Santa Ana, California 92711-1960. On October 16, 2001, I served the within:

- 7
- 8 **1. NOTICE OF MOTION AND MOTION OF GEN-PROBE INCORPORATED FOR PARTIAL**
 - 9 **SUMMARY JUDGMENT OF NON-INFRINGEMENT UNDER THE DOCTRINE OF**
 - 10 **EQUIVALENTS**
 - 11 **2. MEMORANDUM OF POINTS AND AUTHORITIES OF PLAINTIFF GEN-PROBE**
 - 12 **INCORPORATED IN SUPPORT OF ITS MOTION FOR PARTIAL SUMMARY JUDGMENT OF**
 - 13 **NON-INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS**
 - 14 **3. DECLARATION OF DR. KARY B. MULLIS IN SUPPORT OF GEN-PROBE**
 - 15 **INCORPORATED'S MOTION FOR PARTIAL SUMMARY JUDGMENT OF NON-**
 - 16 **INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS**
 - 17 **4. SEPARATE STATEMENT OF UNDISPUTED FACTS IN SUPPORT OF PLAINTIFF GEN-**
 - 18 **PROBE INCORPORATED'S MOTION FOR PARTIAL SUMMARY JUDGMENT OF NON-**
 - 19 **INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS**
 - 20 **5. NOTICE OF LODGMENT IN SUPPORT OF PLAINTIFF GEN-PROBE INCORPORATED'S**
 - 21 **MOTION FOR PARTIAL SUMMARY JUDGMENT OF NON-INFRINGEMENT UNDER THE**
 - 22 **DOCTRINE OF EQUIVALENTS**

23 on the interested parties in this action by personally hand delivering a copy of said document(s) to
the address(es) listed below:

24 John H. L'Estrange, Jr. Esq.
25 Wright and L'Estrange
701 B Street, Suite 1550
San Diego, CA 92101
26 Tel: (619) 231-4844
Fax: (619) 231-6710

27 **Attorneys for Vysis, Inc.**

28
COOLEY GODWARD LLP
ATTORNEYS AT LAW
SAN DIEGO
307419 v1/SD
6L7F01!.DOC

99CV2668 H (AJB)

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct, and that this declaration was executed on October 16, 2001.

SIGNATURE: / S /
PRINT NAME: _____